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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,897	01/31/2000	Timothy E. Dickson	2400-384	4099

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WITHROW & TERRANOVA, P.L.L.C.
P.O. BOX 1287
CARY, NC 27512

EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/494,897

Applicant(s)

DICKSON, TIMOTHY E.

Examiner

Maria N. Von Buhr

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003 and 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. A Request for Continued Examination (RCE) under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR §1.114, and the fee set forth in 37 CFR §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114.
2. Examiner acknowledges receipt of Applicant's response to the previous Office action, received June 3, 2003; which introduces claim 47. Claims 1-47 are now pending in this application.
3. The declarations filed on January 16, 2002 and June 3, 2003 under 37 CFR §1.131 have been considered but are ineffective to overcome the Myers et al. reference (U.S. Patent No. 6,296,148).

As per MPEP §715, "The affidavit or declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR §1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred").

Applicant is required to specifically point out how the facts and evidence of the supporting exhibits support the claim elements. Examiner can then make the legal determination of whether the facts relied upon are adequate to establish conception of the claimed invention.

In this regard, the scope of the declarations is not commensurate with the scope of the claim(s). Applicant's declaration submitted January 16, 2003 refers to "the second and fourth bullet points of PM 9914 [to] illustrate the concept of the present invention." However, these bullet points seem to have no relationship to the instantly claimed "reporting an amount of fuel alleged to be dispensed," "comparing the reported amount to a reference related to a flow rate" and "determining if the reported amount is within a confidence interval" (specifically, as per instant claim 1, also applying to each of the other independent claims). Instead, bullet points 2 and 4 appear to be related to vapor return and time of fuel delivery. If Applicant intended to refer to bullet points 3 and 5, instead, then the declaration needs to be corrected.

Furthermore, even with such a correction, Examiner notes that the limitations of claims 6-8, 22 and 24, related to locations of components (central vs. remote), claims 14-16, 26, 33 and 44, related to alarms, claims 17-19, 34, 35 and 39, related to location of data generation, claim 20, related to maximum allowable flow rates, claims 28 and 29, related to user interfaces, and claims 32 and 38, related to plural comparisons during a single fueling transaction, have not been addressed by the declarations at all.

4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Myers et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence provided to support conception prior to the effective filing date of the reference is insufficient. Applicant alleges that conception was in February of 1999, but the only documentary evidence of such conception (PM 9914) was created on March 18, 1999. Furthermore, in response to Applicant's declaration submitted June 3, 2003, that date of March 18, 1999 is now in question, because the "screen shot of the statistics tab" for the file, as submitted by Applicant, indicates a modification date of March 7, 2003, along with an indication of 9 revisions for the file. Applicant has provided no evidence for what the file included between the dates of March 18, 1999 (when it was created) and March 31, 1999 (the effective filing date of the Myers et al. reference). Hence, Applicant has no actual, documentary evidence of conception prior to the effective filing date of the Myers et al. reference.

Also, the E-mail accompanying the declarations submitted on January 16, 2003 (as exhibit A of Applicant's declaration) is deemed not to be evidence of conception prior to the effective date of the Myers et al. reference, because no mention is made of any of the instantly claimed limitations. Applicant does mention that he "wrote the original patent notes and fleshed out the idea" in February of 1999, but has provided no evidence of any such notes.

5. Although not actually stated, it appears from the submitted declarations that Applicant is attempting to show prior invention by showing conception of the invention prior to the effective date of the Myers et al. reference coupled with due diligence from prior to the reference date (March 31, 1999) to the filing date of this application (constructive reduction to practice). In this regard, the evidence submitted is sufficient to establish Applicant's alleged actual reduction to practice of the invention in this country after the effective date of the Myers et al. reference, since Applicant filed the instant patent application, on January 31, 2000.

6. In determining the sufficiency of a 37 CFR §1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date of the reference is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). Since conception prior to the effective date of the Myers et al. reference has not yet been clearly established, diligence cannot yet be addressed. However, in the interests of compact prosecution, Examiner has additionally considered the evidence provided by Applicant in this regard. Initially, the evidence submitted seems to be sufficient to establish diligence from the April 12, 1999 date supplied by Applicant, as the date that PM 9914 was presented to Applicant's representative, to either a constructive reduction to practice or an actual reduction to practice (in this case, the filing of the instant patent application, as noted above in paragraph 5), as evidenced by the declaration and accompanying exhibits of Applicant's representative, Mr. Steven N. Terranova. However, some question may still exist with regard to evidence of diligence on Applicant's part, from conception to the April 12, 1999 date.

7. Examiner notes that Applicant's most recent declaration (submitted June 3, 2003) did not stand on its own, but instead referred to Applicant's previous declaration (submitted January 16, 2003). Any further submissions of declarations under 37 CFR §1.131 should stand on their own, and be complete in and of themselves, to avoid any potential for confusion.

8. Since Applicant's declarations under 37 CFR §1.131 have been found to be insufficient to establish prior invention, claims 1-46 stand rejected under 35 U.S.C. §102(e), as being clearly anticipated by Myers et al. (U.S. Patent No. 6,296,148), as previously presented in Paper No. 4 (mailed June 4, 2002) and further explained in Paper No. 6 (mailed November 26, 2002).

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claim 47 is rejected under 35 U.S.C. §102(e), as being clearly anticipated by Myers et al. (U.S. Patent No. 6,296,148), similarly as previously presented with regard to claims 1-46, in Paper No. 4 (mailed June 4, 2002) and further explained in Paper No. 6 (mailed November 26, 2002). As per the "pulser" claim language, such a limitation was already addressed in above-noted Paper No. 6. Also, Applicant already admitted in Paper No. 5, received September 16, 2002, that the Myers et al. reference teaches such use of a pulser.

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR §1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR §1.114. Accordingly, **THIS ACTION IS MADE FINAL**, even though it is a first action after the filing of a Request for Continued Examination (RCE) and the submission under 37 CFR §1.114. See MPEP §706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any response to this **FINAL** Office action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to the Office at:

(703) 746-7238 - for formal communications intended for entry, mark "FORMAL";
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".


Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

MNVB
6/12/03


MARIA N. VON BUHR
PRIMARY PATENT EXAMINER
ART UNIT 2125